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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,627	10/02/2000	Frank D'Aguanno	18574.00201	4728

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EXAMINER
SHANLEY, DANIEL G

ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/676,627	D'AGUANNO, FRANK	
	Examiner	Art Unit	
	Daniel G. Shanley	3723	

-- *The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *26 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *1 and 2* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *3-4,6,7 and 9-12* is/are rejected.

7)☐ Claim(s) *5 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Claims 1-2 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

To clarify the original election/restriction requirement, the class/subclass information listed is incorrect.

Claims 1-2, drawn to a method of removing a head of golf club from a shaft of the golf club, should be classified in class 273/80.3.

Claims 3-12, drawn to an apparatus for removing a head of a golf club from a shaft of a golf club, should be classified in class 269/909.

In response to the applicant's arguments, claims 3-12 are drawn to an apparatus which can be used as a work holder for any object. Moreover, the apparatus can be used to practice a materially different process not requiring an epoxy heating step, nor a golf club. The language in Claims 3 and 4, line 2 and 5 respectively, recite the language "the golf club." However, the golf club is not a positive structural limitation. The claim does not require that the apparatus be used for holding a golf club. However, the method claim requires the specific use of golf club and a securing device (not necessarily the clamping mechanism disclosed in the apparatus claims). Therefore, the inventions are distinct and involve varying scopes which require different classifications and searches.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-4 recite the phrase "the golf club," in lines 3 and 5 respectively. Is this language merely intended use, or is the applicant purporting to positively recite the golf club as a structural limitation and therefore a required element in the applied prior art reference?

Claim 3, uses the phrase "the shaft" in part c, iv. It would be less ambiguous if "the hollow shaft" was used as in claim 4. It is a little confusing in light of the fact of that the term "a golf shaft" is referred to in the preamble. Essentially, two shafts are in the claim, a hollow shaft and a golf shaft.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall.

Marshall, in Figures 8 and 9, disclose spring loaded device that separates a golf club head and a golf club shaft.

The following is an element for element analysis of claim 3:

A frame (43); a clamping mechanism (44), and a force mechanism (generally at 15). The force mechanism includes a hollow shaft (phantom lines #45) having an open end and a closed end (generally indicated in Figure 1 at numeral 28) connected to the distal end of the piston (30 & 34), a spring (36), and a turret (14) having a smaller diameter portion (18) insertable in open end of hollow shaft and a larger diameter portion (16) being external to the shaft and engageable with the shaft of the golf club and golf club head.

Additionally, claim 3, requires a hydraulic piston to be used. On column #2, lines 38-42, the specification states that the biasing means utilized for driving the shaft engaging member away from the club head cam be pneumatic, hydraulic, or some other form such as manual advancement/retraction of piston. Additionally, the clamping mechanism is manually actuable.

In reference to claim 4, frame 43 includes a block (44) having a bore (45). The term connected to is sufficiently broad to encompass the frame clamping member structural relationship. The two elements, the frame (43) and the clamping member (44), appear connected through screw means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4, 6-7, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of being of routine skill in the art.

Marshall, discussed in detail above, disclosed the invention except for having a spring residing within the hollow shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the spring within the hollow tube, since it has been held that rearranging of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall as applied to claim 4 above, and further in view of Chu.

Marshall, discloses all the limitations of the invention except for turret with a plurality of recesses. Chu discloses such a device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Marshall as applied to claim 4 and included a multiple recessed turret, since Chu discloses in column #3, lines 1-9 that such a modification for assembly of golf clubs is desirable for accommodating club shafts of different diameters.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall as applied to claim 4 above, and further in view of Farino.

Marshall, discloses all the limitations of the invention except a manually actuable screw for adjusting the magnitude of the screw and piston in a horizontal plane within the longitudinal extremities of the frame. Farino discloses such a device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Marshall as applied to claim 4 and include manual adjustment devices, since Farino demonstrates that manually operated adjustment devices may be more feasible for use in golf shops where simplicity is required for non-skilled machinists.

Allowable Subject Matter

Claims 5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Milan and Rigal disclose devices for golf club assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. Shanley whose telephone number is 703-305-0306. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703-308-2687. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-308-3590 for regular communications and 703-308-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

DGS
March 22, 2002

Joseph J. Hail, III
Supervisory Patent Examiner
Technology Center 3700